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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,043	01/28/2004	Tomoko Maruyama	204552031700	9599
7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102				
10/02/2009				
EXAMINER				
CHEEMA, UMAR				
ART UNIT		PAPER NUMBER		
2444				
MAIL DATE		DELIVERY MODE		
10/02/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,043

Applicant(s)

MARUYAMA ET AL.

Examiner

UMAR CHEEMA

Art Unit

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the Request for Continued Examination (RCE) transmitted on 08/19/2009. Claims 1-15 are pending with claims 1, 11, and 12 as being independent claims.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/19/2009 has been entered.

Response to Arguments

3. Applicant's arguments with respect to claims 1-15 have been considered but they are deemed not persuasive. Applicant assert to argue regarding claim 1 that combination of cited references fails to teach or suggest, "a second setting station for setting up an optional sender address representing a sender in place of a sending station address specifying the network scanner device and transmitting the image data within the sending station address and not the optional sender address when the optional sender address is not set up in place of the sending station address". Applicant's arguments have been fully considered but Examiner disagrees with Applicant's argument. As detailed in below rejection, Partial Translation of JP 2000-

215124 (hereinafter Partial) clearly teach or suggests as shown in (paragraphs [0039, 0045, 0053-0055], also figures 10, 1, 11, 17 and the details associated), wherein choosing the destination from the destination list in the embodiment is shown in figure 17. First, the destination list button of the panel section 7 is pushed at step s81 and the sender's ID is inputted at and step s82, the destination list registered by email will be displayed on the panel section 7. . . transmitted to the destination (steps s85-s87) etc. Partial further goes on to explain registering the sender's ID and the sending station address is carried out making them correspond to each other at step s75 in figure 16 (see paragraphs [0055-0057]). The breadth of the claims allows for such an interpretation. Applicant employs broad language which includes the use of words and phrases which have broad meaning in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meaning which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly as reasonably possible, in determining patentability of the disclosed invention. Again, claims are interpreted in light of the specification; limitations from the specification are not read into the claims. See *In re Van Geuns*, 998 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is examiner's position that cited references teach or suggest at least substituting of sender address in place of sending station address as required in claim 1 and similarly in Independent claims 11 and 12 for at least given reasons above. Therefore, 35 U.S.C 103(a) rejection to claims 1-15 is proper.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's claims have limitation: "wherein transmitting the image data with the sending station address and not the optional sender address when the optional sender address is not set up in place of the sending station address", which is a negative limitation that rendered the claims indefinite (See MPEP 2173.05 (i) Negative Limitations section). Since Claims 1, 11, and 12 are rejected under 35 USC §112, therefore, all of their dependent claims are rejected for at least based on their respective dependencies.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh (US 2001/0021037 A1) in view of Partial Translations of JP 2000-215124 A (Partial).
6. **Regarding claim 1**, Itoh discloses the invention as claimed a network scanner device for transmitting image data through a network (see abstract, pg. 1, par. 0015-0016) comprising: a reading section for scanning a document to obtain image data (see abstract, pg. 1, par. 0018), a first setting section for setting up a recipient address to which the image data is to be transmitted (pg. 1, par. 0019), a second setting section for setting up an optional sender address representing a sender in place of a sending station address specifying the network scanner device by accepting a designation of the sender address which is distinct from the sending station address (see pg. 1, par. 0020, fig. 10- where IP address is the address of the sender instead of the sending location address; also see par. 0059, 0146; sender and IP address of the transmitting destination), and a transmission control section for carrying out control for (a) adding to the image data the sender address set by the second setting section when the optional sender address is set up in place of the sending station address, and (see pg. 1, par. 0017, pg. 6, par. 0146, fig. 10, pg. 5, par. 0111) and transmitting the image data to the recipient address set by the first setting section (see pg. 1, par. 0022) (b) transmitting the image data with the sending station address and not the optional sender address when the optional sender address is not set up in place of the sending station address.

7. Itoh substantially discloses the invention as claimed above for the given reason however does not explicitly disclose wherein setting up a sender's address is sender's address instead of sending station address and the optional sender address is set up in place of the sending station address, and transmitting the image data with the sending station address and not the optional sender address when the optional sender address is not set up in place of the sending station address.

8. In the same field of invention Partial discloses wherein setting up a sender's address is sender's address instead of sending station address and the optional sender address is set up in place of the sending station address, and transmitting the image data with the sending station address and not the optional sender address when the optional sender address is not set up in place of the sending station address (see par. [0039, 0045, 0053-0055], figures 10, 1, 11, 17 and the details associated).

9. It would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Itoh and Partial for a network scanner device for transmitting data over a network. Motivation for doing so would have been that this method provides users more options to monitor and transmit image data over a network.

10. **Regarding claim 2**, Itoh discloses a network scanner device as claimed in claim 1, further comprising a one-touch setting section (see pg. 1, par. 0021) for setting up the recipient address and the sender address simultaneously (see pg. 1, par. 0021, pg. 2, par. 0050).

11. **Regarding claim 3**, Itoh discloses a network scanner device as claimed in claim 2, wherein the one-touch setting section (see pg. 1, par. 0021) carries out setting of the recipient address and the sender address, in accordance with instructions by the sender (see pg. 2, par. 0050).
12. **Regarding claim 4**, Itoh discloses a network scanner device as claimed in claim 2, further comprising a display section that is capable of displaying information including the recipient address and the sender address (see fig. 1, pg. 2, par. 0049, pg. 3, par. 0070, pg. 6, par. 0146).
13. **Regarding claim 5**, Itoh discloses a network scanner device as claimed in claim 1, further comprising a storage section in which candidates of recipient addresses associated with each sender address are stored (see pg. 3, par. 0074), wherein, on setting of the sender address, the recipient address is chosen from candidates of recipient addresses associated with the sender address (see fig. 10, pg. 6, par. 0146).
14. **Regarding claim 6**, Itoh discloses a network scanner device as claimed in claim 1, further comprising a storage section in which sender addresses associated with IDs representing users are stored (see pg. 2, par. 0054), wherein the sender address is automatically set up in accordance with an inputted ID (see pg. 3, par. 0073).
15. **Regarding claim 7**, Itoh discloses a network scanner device as claimed in claim 6, further comprising an ID input prompting section for making a display that prompts input of an ID representing a user, as a condition for start of operations of the device (see fig. 1, pg. 2, par. 0049, pg. 3, par. 0073).

16. **Regarding claim 8**, Itoh teaches a network scanner device as claimed in claim 1, further comprising an operation panel by which information including the recipient address and the sender address is inputted or chosen (see abstract, pg. 1, par. 0019).

17. **Regarding claim 9**, Itoh discloses a network scanner device as claimed in claim 1, wherein information including the recipient address and the sender address can be inputted through the network (see pg. 1, par. 0055).

18. **Regarding claim 10**, Itoh discloses a network scanner device as claimed in claim 1, wherein the sending station address specifying the device is included in contents of a text of mail to which the image data is added (see pg. 5, par. 0132).

19. **Regarding claim 11**, Itoh discloses the invention as claimed a network scanner device for transmitting image data through a network (see abstract, pg. 1, par. 0015-0016), comprising: image memory in which image data is stored (see fig. 2, pg. 2, par. 0056), a first setting section for setting up a recipient address to which the image data is to be transmitted (see pg. 1, par. 0019), a second setting section for setting up an optional sender address representing a sender in place of a sending station address specifying the network scanner device by accepting a designation of the sender address which is distinct from the sending station address (see pg. 1, par. 0020, pg. 6, par. 0146, fig. 10 -- where IP address is the address of the sender instead of the sending location address; also see par. 0059, 0146; sender and IP address of the transmitting destination), and a transmission control section for carrying out control for (a) adding to the image data the sender address set by the second setting section when the optional sender address is set up in place of the sending station address, and (see pg. 1, par.

0017, pg. 6, par. 0146, fig. 10, pg. 5, par. 0111) and transmitting the image data to the recipient address set by the first setting section (see pg. 1, par. 0022) (b) transmitting the image data with the sending station address and not the optional sender address when the optional sender address is not set up in place of the sending station address.

20. Itoh substantially discloses the invention as claimed above for the given reason however does not explicitly disclose wherein setting up a sender's address is sender's address instead of sending station address and the optional sender address is set up in place of the sending station address, and transmitting the image data with the sending station address and not the optional sender address when the optional sender address is not set up in place of the sending station address.

21. However in the same field of invention Partial discloses wherein setting up a sender's address is sender's address instead of sending station address and the optional sender address is set up in place of the sending station address, and transmitting the image data with the sending station address and not the optional sender address when the optional sender address is not set up in place of the sending station address (see par. [0039, 0045, 0053-0055], figures 10, 1, 11, 17 and the details associated).

22. It would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Itoh and Partial for a network scanner device for transmitting data over a network. Motivation for doing so would have been that this method provides users more options to monitor and transmit image data over a network.

23. **Regarding claim 12**, Itoh discloses the invention as claimed an image data transmitting method of a network scanner device (see abstract, pg. 1, par. 0015-0016) which attaches image data to electronic mail and transmits the image data through a network (see pg. 1, par. 0112-0113), comprising steps of: scanning a plurality of documents to obtain the image data (see pg. 1, par. 0002), setting first and second recipient addresses to which respective first and second parts of the image data are to be transmitted (see pg. 1, par. 0019), setting an optional sender address representing a user in place of a sending station address specifying the network scanner device by accepting a designation of the sender address which is distinct from the sending station address (see pg. 1, par. 0020, pg. 6, par. 0146, fig. 10 -- where IP address is the address of the sender instead of the sending location address; also see par. 0059, 0146; sender and IP address of the transmitting destination), adding the set sender address to the first part of the image data in place of the sending station address and transmitting the image data to the first recipient address through the networks (see pg. 1, par. 0112-0113, pg. 7, par. 0174, pg. 5, par. 0111); transmitting the second part of the image data, together with the sending station address, to the second recipient address.

24. Itoh substantially discloses the invention as claimed above for the given reason however does not explicitly disclose wherein setting up a senders address is senders address instead of sending station address and the optional sender address is set up in place of the sending station address, and transmitting the second part of the image data, together with the sending station address, to the second recipient address.

25. However in the same field of invention Partial discloses wherein setting up a senders address is senders address instead of sending station address and the optional sender address is set up in place of the sending station address, and transmitting the second part of the image data, together with the sending station address, to the second recipient address (see par. [0039, 0045, 0053-0055], figures 10, 1, 11, 17 and the details associated).

26. It would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Itoh and Partial for a network scanner device for transmitting data over a network. Motivation for doing so would have been that this method provides users more options to monitor and transmit image data over a network.

27. **Regarding claim 13**, Itoh discloses an image data transmitting method as claimed in Claim 12, wherein the step of scanning a document and obtaining image data (see pg. 1, par. 0015), the step of setting the recipient address to which the image data is to be transmitted (see pg. 1, par. 0019), and the step of setting the sender address representing the sender in place of the sending station address specifying the device are carried out in an altered sequence (see pg. 1, par. 0020, pg. 4, par. 0090, pg.7, par. 0164).

28. **Regarding claim 14**, Itoh discloses a network scanner device as claimed in claim 1, wherein the designation of the sender address is carried out by a user selection from addresses stored in the network scanner device in advance (see par. 0059, 0146; sender and IP address of the transmitting destination).

29. **Regarding claim 15**, Itoh discloses a network scanner device as claimed in claim 1, wherein the designation of the sender address is carried out by an input of the sender address by a user (see par. 0059, 0146, 0106; figure 7, inputs the IP address as the transmitting destination).

Conclusion

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to UMAR CHEEMA whose telephone number is (571)270-3037. The examiner can normally be reached on M-F 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Jr. Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2444

/U. C./

Examiner, Art Unit 2444

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444